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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,583	11/18/2003	Deborah Overoyen	16356-002001	4738
26191	7590	12/06/2005	EXAMINER	
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			COE, SUSAN D	
			ART UNIT	PAPER NUMBER
			1655	

DATE MAILED: 12/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/715,583	<b>Applicant(s)</b> OVEROYEN, DEBORAH	
	<b>Examiner</b> Susan D. Coe	<b>Art Unit</b> 1655	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/25/05</u> . | 6) <input type="checkbox"/> Other: ____  |

### **DETAILED ACTION**

1. Claims 1-26 are currently pending.

#### ***Specification***

2. The use of the trademarks "Greenies," "Milkbones," "Friskies," "Whiskas," and "Pounce" have been noted in this application. They should be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 is indefinite because the definition of "Greenies" is unclear.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 1, 3, and 4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 3, and 4 are directed to a product found in nature. *Salvadora persica* sticks are a naturally occurring product and naturally contains flavors, vitamins, nutrients and antibiotics. Thus, the product as claimed in claims 1, 3, and 4 is non-statutory because it is a natural product.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-8, 10, 11, 16 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by prior art admitted by applicant in the specification.

On page 3 of the specification, applicant admits that *S. persica* sticks are known products. Applicant admits that these products are typically 15 to 20 cm in length (about 6 to 8 inches). Applicant also admits that extracts of *S. persica* are known.

Applicant does not admit that the claimed product label is known; however, the addition of printed matter to an existing product does not distinguish the product in terms of patentability (see *In re Ngai*, 70 USPQ2d 1862 (CA FC 2004)). Thus, the product admitted by applicant is not considered to be patentably distinct from the claimed product.

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6. Claims 1, 3-7, 16, 21 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Almas (Journal of Contemporary Dental Practice (August 2002), vol. 3, no. 3, pp. 1-10).

The reference teaches that *S. persica* chewing sticks are known. The reference teaches that these sticks have antibacterial properties and are used to clean the teeth (see page 2). These sticks would naturally contains nutrients, flavors, and vitamins. Thus, *S. persica* sticks are known. The reference also teaches extracts from *S. persica* (see page 4).

The reference does not teach labeling the product as claimed; however, the addition of printed matter to an existing product does not distinguish the product in terms of patentability (see *In re Ngai*, 70 USPQ2d 1862 (CA FC 2004)). The reference also does not teach using the product for a companion animal. However, this is considered a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

7. Claims 1, 3-7, 16, 21, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Almas et al. (Biomedical Letters (1999), vol. 60, pp. 71-75).

The reference teaches that *S. persica* chewing sticks are known. The reference teaches that these sticks have antibacterial properties and are used to clean the teeth. These sticks naturally contains nutrients, flavors, and vitamins (see page 71). Thus, *S. persica* sticks are known. The reference also teaches extracts from *S. persica* (see page 72).

The reference does not teach labeling the product as claimed; however, the addition of printed matter to an existing product does not distinguish the product in terms of patentability

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(see *In re Ngai*, 70 USPQ2d 1862 (CA FC 2004)). The reference also does not teach using the product for a companion animal. However, this is considered a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

8. Claims 1, 3-7, 16, 20-23, 25, and 26 rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,009,886.

The reference teaches sticks from *S. persica* (see paragraph spanning columns 1 and 2). These sticks would naturally contains nutrients, flavors, and vitamins. The reference also teaches using an extract from *S. persica* to make rinses and toothpastes (see Examples and claims).

The reference does not teach labeling the product as claimed; however, the addition of printed matter to an existing product does not distinguish the product in terms of patentability (see *In re Ngai*, 70 USPQ2d 1862 (CA FC 2004)). The reference also does not teach using the product for a companion animal. However, this is considered a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Almas (Journal of Contemporary Dental Practice (August 2002), vol. 3, no. 3, pp. 1-10).

The teachings of this reference are discussed above. The reference does not specifically teach using sticks in the lengths claimed. The length of the stick is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal stick length in order to best achieve the desired oral care results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of stick length would have been obvious at the time of applicant's invention.

10. Claims 1-3, 5, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Almas (Journal of Contemporary Dental Practice (August 2002), vol. 3, no. 3, pp. 1-10) in view of US Pat. No. 5,033,410.

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The teachings of Almas are discussed above. The reference does not specifically teach coating the stick with a flavoring such as those claimed by applicant in claim 2. US '410 teaches using flavored chew items for animals to clean their teeth. Any desirable flavor can be used. Specific example of flavorings include beef and cod liver oil (see paragraph spanning columns 1 and 2). Thus, it was known in the art at the time of the invention to coat teeth cleaning items with flavorings. A person of ordinary skill in the art would reasonably expect that the *S. persica* sticks taught by Almas could be used for animals and would be more attractive to the animals if coated with desirable flavors. Therefore, it would be an obvious modification to coat the chewing stick taught by Almas with flavors desirable for animals as taught by US '410.

11. Claims 8-15 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,009,886.

The teachings of this reference are discussed above. The reference does not specifically teach using sticks in the lengths claimed. The length of the stick is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Thus, optimization of general conditions is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal stick length in order to best achieve the desired oral care results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of stick length would have been obvious at the time of applicant's invention.



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In addition, the reference does not specifically teach impregnating toothbrush bristles with the *S. persica* extract. However, since the extract is known to have beneficial effects on the teeth, a person of ordinary skill in the art would reasonably expect that the extract could be impregnated directly into the bristles of a toothbrush. This reasonable expectation of success would motivate the artisan to modify the reference in this manner.

12. Claims 1-3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,009,886 in view of US Pat. No. 5,033,410.

The teachings of US '886 are discussed above. The reference does not specifically teach coating the stick with a flavoring such as those claimed by applicant in claim 2. US '410 teaches using flavored chew items for animals to clean their teeth. Any desirable flavor can be used. Specific example of flavorings include beef and cod liver oil (see paragraph spanning columns 1 and 2). Thus, it was known in the art at the time of the invention to coat teeth cleaning items with flavorings. A person of ordinary skill in the art would reasonably expect that the *S. persica* sticks taught by Almas could be used for animals and would be more attractive to the animals if coated with desirable flavors. Therefore, it would be an obvious modification to coat the chewing stick taught by US '886 with flavors desirable for animals as taught by US '410.

13. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,009,886 in view of US Pat. No. 4,145,447.

The teachings of US '886 are discussed above. The reference does not specifically teach using the extract in a chewable food, treat, snack or toy. US '447 teaches that these forms are known to be used for oral care products. US '447 teaches adding oral care medicaments to these forms (see abstract and column 3). Thus, a person of ordinary skill in the art would reasonably

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expect that the *S. persica* extract of US '886 could be incorporated in oral care products as taught by US '447. This reasonable expectation of success would motivate an artisan of ordinary skill to make such a modification to the references.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 3-7, and 15-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/872,689. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to *S. persica* extract and stick products (Appl. '689 teaches a toothpick which is considered a stick).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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15. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 9:30 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey, can be reached at (571) 272-0775. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding can be directed to the receptionist whose telephone number is (571) 272-1600.

  
11-28-05

Susan D. Coe  
Primary Examiner  
Art Unit 1655